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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,429	04/12/2004	Jean-Luc Collet	FR920030001US1	2553

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EXAMINER
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TRAN, PHILIP B

ART UNIT	PAPER NUMBER
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2155

NOTIFICATION DATE	DELIVERY MODE
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06/13/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/822,429	<b>Applicant(s)</b> COLLET ET AL.	
	<b>Examiner</b> Philip B. Tran	<b>Art Unit</b> 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 7 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "... the called web service" in lines 8-9. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "... the called web service" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "... the called web service" in line 8. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 7 and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 7 and 10:

- **registering the at least one client request to call a web service within the callback web service, while simultaneously invoking the called web service by sending the at least one client request to call a web service to the called web service.**

Therefore, claims 7 and 10 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claimed limitations. Applicant is requested to point

out where in the specification of the instant application supports above claimed limitations in claims 7 and 10.

(2) Claims 7 and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 7 and 10:

- **registering the at least one client request to call a web service within the callback web service, while simultaneously invoking the called web service by sending the at least one client request to call a web service to the called web service.**

Undue experimentation would be needed to registering the at least one client request to call a web service within the callback web service, while simultaneously invoking the called web service by sending the at least one client request to call a web service to the called web service.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Bau, III et al (Hereafter, Bau), U.S. Pat. Application Pub. No. US 2003/0023957 A1.

Regarding claim 1, Bau teaches a system for handling a web service call by clients in a communication network comprising:

client requester means for issuing client requests comprising at least one client request to call a web service, wherein the at least one client request to call a web service is sent to a called back web service (= client requests a call to web services 104 of web server 102) [see Fig. 1];

callback web service means coupled to the client requester means for registering the at least one client request to call a web service within the callback web service and for invoking the called web service by sending the at least one client request to call a web service to the called web service (= callbacks to web service) [see Paragraphs 0045-0049 & 0059-0062]; and

response web service means coupled to the callback web service means for receiving a response to the at least one client request to call a web service and coupled to the client requester means for delivering the response when a client request to obtain the response is issued from the client requester means (= response to callback web service) [see Paragraphs 0059-0062 & 0074].

Regarding claim 2, Bau further teaches the system of claim 1 wherein the callback web service means further comprise storage means to store a client identity along with a client request [see Paragraphs 0044-0048].

Regarding claim 3, Bau further teaches the system of claim 2 wherein the callback web service means further comprise means for determining whether the at

least one client request to call a web service is already stored or not within the storage means [see Paragraphs 0038 & 0074].

Regarding claim 4, Bau further teaches the system of claim 1 wherein the client requests further comprise at least one client request to subscribe to an already stored at least one client request to call a web service see Paragraph 0047].

Regarding claims 5-6, Bau further teaches the system of claim 1 wherein the at least one client request to call a web service comprises at least one parameter to define a protocol to be used for delivering the response to the client, wherein the protocol is a Simple Mail Transfer Protocol (SMTP) or a Simple Object Access Protocol (SOAP) [see Paragraphs 0048-0049 & 0062].

Claim 7 is rejected under the same rationale set forth above to claim 1.

Claims 8-9 are rejected under the same rationale set forth above to claims 2-3.

Claim 10 is rejected under the same rationale set forth above to claim 7.

### ***Response to Arguments***

6. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

Applicant argues that regarding independent claims 1, 7 and 10, Bau fails to disclose, "a separate element (a callback web service) that receives the client request and subsequently sends the request to the web service" [see Remarks, Page 6].



The examiner respectfully disagrees. Based on the reasonably broadest interpretation, Bau teaches a system for handling a web service call by clients in a communication network comprising client requests a call to web services 104 of web server 102 [see Fig. 1] with invoking callbacks to web service [see Paragraphs 0045-0049 & 0059-0062] and there is a response to callback web service in response to a client request to obtain the response [see Paragraphs 0059-0062 & 0074]. The language of the claim does not require a separate element such as a callback web service as argued by applicant.

Applicant argues that regarding independent claims 1, 7 and 10, Bau fails to disclose, "callback web service means coupled to the client requester means for simultaneously registering the at least one client request to call a web service and invoking the called web serviced by sending the at least one client request to call a web service to the called web service" [see Remarks, Page 7].

The examiner respectfully disagrees. Regarding claim 1, claim 1 does not have the term "simultaneously" in the claim language as argued by applicant. Moreover, Specification of this application does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 7 and 10 "registering the at least one client request to call a web service within the callback web service, while simultaneously invoking the called web service by sending the at least one client request to call a web service to the called web service."

In addition, it is still irrelevant for applicant to argue that a response to a client request is automatically or manually delivered when the response becomes available because that feature is not in the claim.

In view of the foregoing, the examiner asserts that the cited reference (Bau et al, U.S. Pat. Application Pub. No. US 2003/0023957 A1) does teach or suggest the subject matter recited in independent claim. Dependent claims depend on independent claim and are therefore rejected at least by virtue of their dependency on independent claim and by other reasons set forth above in the rejection section. Accordingly, the examiner respectfully maintains the rejections for claims 1-10 as shown above

***Other References Cited***

7. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

- A) Goss et al, U.S. Pat. No. 6,654,815.
- B) Salahshoor et al, U.S. Pat. No. 7,337,237.
- C) Khodabakchian et al, U.S. Pat. Application Pub. No. US 2003/0093500 A1.

8. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip B Tran/  
Primary Examiner, Art Unit 2155  
June 08, 2008